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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,136	08/20/2003	Jeffrey Larson	001227.0144	7146
69095 7590 03/20/2008 STROOCK & STROOCK & LAVAN, LLP 180 MAIDEN LANE NEW YORK, NY 10038				
EXAMINER				
PHILOGENE, PEDRO				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
03/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/645,136

Applicant(s)

LARSON ET AL.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 13 is/are allowed.
6) ☒ Claim(s) 1-12, 15-28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-856)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/8/08 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13,15-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7,014,608. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 1 are to be found in claim 1 (as it encompasses claims 2, 3), claim 4, claim 5 (as it encompasses claims 6-12), claim 13 (as it encompasses claims 15-16). The difference between claims 1 of the application and claims 1,4,5,13 of

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the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1, 4, 5 and 13 of the patent is in effect a "species" of the "generic" invention of claim 1. It has been held that the generic invention is "anticipated" by the "species". See *in re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 1 is anticipated by claims 1, 4, 5 and 13 of the patent, it is not patentably distinct from claims 1, 4, 5, and 13.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant fails to disclose a retractor having a length and width, the length of the retractor being at least twice as long as the width when the tissue retaining wall is in the closed position.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12,15-18, 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. (5,728,046) in view of Smith et al. (7,261,688) in view of Engelhardt et al. (5,027,793).

Mayer et al disclose a retractor, as best seen in FIG. 1, comprising a frame (5) having a first guide receiving channel (20,21) a first tissue retaining wall (7); and a second tissue retaining wall (18,19) wherein each of the retaining walls has a substantially flat side, as best seen at 25,45, wherein one of the first tissue retaining wall and the second tissue retaining wall is coupled to the frame (5 as it encompasses arms 1,2,3,4,) as best seen in FIG.1 and a first guide (29) having an end, the first guide being sized and dimensioned to be received within the first guide receiving channel, the end being sized and dimensioned to be insertable into a first area of bone; as best seen in FIGS.1-3. The retaining wall has a curved bottom surface, as best seen in FIG.1. The retractor further comprising a frame (5) having a mechanism that holds the retaining walls apart from each other, wherein the first and second guide receiving channels (20, 21) comprises slot disposed in the frame. The first and second tissue retaining walls defining a space (between blades 7, 18, 19), the first and second tissue retaining walls being movably coupled (via holders 8, 9 on the frame) to one another so that the first and second tissue retaining walls are moveable between a closed position and an open position, as set forth in column 4, lines 1-6, the space being larger when the first and second tissue retaining walls are in the open position as compared to the closed position (by moving blades 18, 19 away from blade 7).

It is noted that Mayer et al did not teach of a first and second walls that are movably coupled and a hinge that joins the first and second walls and first and second walls that are nested relative to one another; as claimed by applicant. However, in a similar art, Smith et al evidence the use of a retractor with such characteristics to increase the size of the working channel while minimizing trauma to skin and tissue.

Therefore, given the teaching of Smith et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Mayer et al, as taught by Smith et al to increase the size of the working channel while minimizing trauma to skin and tissue.

It is noted that the above combination of references does not teach of at least a portion of the guide extends through the top surface of the frame and though the first guide receiving channel; as claimed by applicant. However, in similar art, Engelhardt et al provide the evidence the use of a retractor with a frame having guide receiving channels and first and second guides received therein to temporarily attach the retractor to bone.

Therefore, given the teaching of Engelhardt et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Mayer, as taught by Engelhardt et al to temporarily attach the retractor to bone.

As to claim 28, although the above combination is silence about the length and width of the retractor wherein the length of the retractor being at least twice as long as the width when the tissue retaining wall is in the closed position; however, one can

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clearly see that by bringing the blades (7, 18,19) closer together, the length of the retractor of Mayer et al would be at least twice as long as the width when the tissue retaining wall is in the closed position, since applicant did not disclose the length nor the width of his retractor.

With respect to the method claims, the method steps, as set forth, would have been obviously carried out in the operation of the device, as set forth above.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. (5,728,046) in view of Smith et al. (7,261,688) in view of Wilhelmy (5,722,977).

It is noted that the above combination of references discloses all the limitations, as set forth above, except for an expander having a handle and sloped walls, as claimed by applicant. However, in similar art, Wilhelmy evidences the use of an expander having a handle and sloped walls to open and maintain a desired space.

Therefore, given the teaching of Wilhelmy, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the expander of Wilhelmy with the device of Mayer et al to open and maintain a desired space

Allowable Subject Matter

Claim 13 is allowed.

Response to Amendment

Applicant's arguments, see Remarks, filed 1/8/08, with respect to the rejection(s) of claim(s) 1-28 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Engelhardt et al/Wilhelmy. Engelhardt et al

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disclose a first and second guides extending through the top surface of a frame and through guide receiving channels, as best seen in FIGS.1-6. Wilhelmly discloses an expander having handle and sloped walls.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
March 13, 2008